

Serial No. 10/810,964
Atty Dkt: 99-851CON1

REMARKS

This Response is filed in reply to the Office Action dated April 14, 2006. Claims 1-26 are pending. Claims 1-26 are rejected. In this Response, no claims are amended, no claims are cancelled and no new claims are added. Accordingly, claims 1-26 remain pending in the application, of which claims 1 and 14 are independent.

Silence with regard to any of the Examiner's rejections is not acquiescence to such rejections. Specifically, silence with regard to Examiner's rejection of a dependent claim, when such claim depends from an independent claim that Applicants consider allowable for reasons provided herein, is not an acquiescence to such rejection of the dependent claim, but rather a recognition by Applicants that such previously lodged rejection is moot based on Applicants' remarks and/or amendments relative to the independent claim (that Applicants consider allowable) from which the dependent claim depends.

The Examiner placed the Information Disclosure Statement (IDS) filed June 28, 2004 in the application file, but did not consider the information, asserting that the IDS failed to comply with 37 C.F.R. §1.98(a)(2) requiring a legible copy of each cited foreign patent document, each non-patent literature publication or that portion which caused it to be listed and all other information or that portion which caused it to be listed. However, as the Examiner is aware, 37 C.F.R. §1.98(d) provides that copies are not required if the information was previously cited by or submitted to, the Office in a prior application, provided that the prior application is properly identified in the IDS and is relied on for an earlier filing date under 35 U.S.C. §120.

The above-referenced IDS and the IDS filed with the application and dated March 26, 2004, identify prior U.S. Application Ser. No. 09/430,597 (now U.S. Patent Ser. No. 6,757,866) as being relied on for an earlier filing date under 35 U.S.C. §120. Applicants further note that the documents were previously cited by or submitted to, the Office in the prior application. Accordingly, Applicants request that the Examiner consider all documents listed in each IDS and that indication of such consideration be provided.

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The Examiner asserted that claims 1, 3-8, 11-14, 16-21 and 24-26 were unpatentable under the judicially created doctrine of "obviousness-type" double patenting with respect to claims 1-8, 10-19 and 21-22 of parent U.S. Patent Ser. No. 6,757,866. As the Examiner knows, obviousness-type double patenting can be overcome by a timely filed terminal disclaimer. Applicants request that the filing of a terminal disclaimer, if necessary, be deferred until allowance and issue of claims in the current application.

The Examiner rejected claims 1-3, 5-16 and 18-26 under U.S.C. §103(a) as being unpatentable over Wistendahl et al., U.S. Patent Ser. No. 5,708,845 (referred to hereinafter as Wistendahl) and further in view of Barr et al. U.S. Patent Ser. No. 5,873,076 (referred to hereinafter as Barr). The Examiner rejected claims 4 and 17 under U.S.C. 103(a) as being unpatentable over Wistendahl and Barr and further in view of Witteman, U.S. Patent Ser. No. 6,243,676 (referred to hereinafter as Witteman).

Applicants traverse the Examiner's rejections under 35 U.S.C. §103(a), and respectfully request reconsideration in view of the remarks herein.

With regard to independent claims 1 and 14, Applicants agree with the Examiner's finding on page 4 of the Office Action that Wistendahl does not teach feature (c) of independent claims 1 and 14. However, the Examiner alleges on page 4 of the Office Action that Barr provides such teaching. Applicants respectfully disagree.

Barr discloses performing a relevance ranking for each of the textual documents and multi-media files identified by a search (col. 13, lines 36-38). A *relevance score* is generated for each document or file in the search result list (col. 13, line 38, 39). The relevance score is based on *term location information*, and more particularly on the *relative proximity within a document of terms forming the search query* (col. 13, lines 42-45). As Barr explains, *the closer various search terms are to one another in the document file, the higher the relevance score* (col. 13 lines 45-47).

Applicants, on the other hand, base the scores associated with the documents on a *ratio between the number of documents in the collection and, for a term in the selected text, the number of documents in the collection containing the term*. Barr does not teach

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or suggest relevance scores based on a ratio. In fact, the only ratio referred to in Barr is an image data compression ratio (col. 28, lines 30-35). Further, Barr is silent with regard to obtaining, determining, or otherwise knowing the number of documents in a collection that contain a term from the selected text. While Barr teaches generating relevance scores for each document or file, the relevance scores taught by Barr bear no resemblance to Applicants' scores based on the ratio recited in claims 1 and 14.

The Examiner asserts that it would have been obvious to combine the teachings of Wistendahl and Barr. As the Examiner knows, a prima facie case of obviousness requires that there be some suggestion or motivation to combine references, that there be a reasonable expectation of success, and that the prior art references teach or suggest all of Applicants' claim features. *In re Vaack*, 947 F. 2d. 488, 20 USPQ2d 1438 (Fed. Cir. 1991). As none of the cited art of Wistendahl and Barr, individually or in combination, teaches all of the features of independent claims 1 and 14, and particularly, *scores based on a ratio between the number of documents in a collection and, for a term in the selected text, the number of documents in the collection containing the term*, a prima facie case of obviousness is not established. Applicants' silence with regard to other requirements of prima facie obviousness is not an acquiescence that such requirements have been satisfied, but rather a recognition that a discussion of such other requirements is unnecessary given the failure of the cited art to teach all features of Applicants' independent claims 1 and 14.

Accordingly, Applicants consider independent claims 1 and 14 to be allowable. Claims 2-13 and 15-26 depend upon one of allowable independent claims 1 and 14, and therefore, are also allowable for depending upon an allowable base claim.

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CONCLUSION

Based on the above and remarks, it is respectfully submitted that the claims and thus this application are in condition for allowance. Accordingly, allowance is requested. If there are any remaining issues or the Examiner believes that a telephone conversation with Applicant's attorney would be helpful in expediting the prosecution of this application, the Examiner is invited to call the undersigned at (972) 718-4800.

Respectfully submitted,

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